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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/932,539	08/17/2001	Gavin J. McIntosh	FMCE-P064	3957

7590 11/28/2003  
Henry C. Query, Jr.  
504 S. Pierce Ave.  
Wheaton, IL 60187

EXAMINER

DOUGHERTY, JENNIFER R

ART UNIT	PAPER NUMBER
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3672

DATE MAILED: 11/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/932,539

Applicant(s)

MCINTOSH, GAVIN J.

Examiner

Jennifer R. Dougherty

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☒ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Priority***

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in the United Kingdom on August 21, 2000. It is noted, however, that applicant has not filed a certified copy of the United Kingdom application as required by 35 U.S.C. 119(b).

2. In response to applicant's request on page 1 of the response filed June 27, 2003, the application file has been thoroughly checked and no certified copy of the UK application is present, nor was the receipt of the UK application even recorded in the file.

### ***Claim Rejections - 35 USC § 102***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1, 3, 6, 7, 8, 10, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Wolff et al. (US 4,082,147).

The invention of Wolff et al. includes all the limitations of claims 1 and 8 including: a production Christmas tree (figure 1) comprising a generally vertical production bore (connecting WL1 and MV), a horizontal production passage (connecting WV1 and WV2), and multiple outlets extending from a single production passage connected to the production bore (at WV1 and WV2).

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With respect to the dependant claims, Wolff et al. also teaches: two production outlets (figure 1)-claims 3 and 10; a horizontal tree (figure 1)-claim 6; and each outlet with a valve (WV1/WV2)-claims 7 and 13.

### ***Claim Rejections - 35 USC § 103***

5. Claims 2, 4, 5, 9, 11, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolff et al. alone.

As discussed above Wolff et al. discloses all the limitations of claims 2, 4, 5, 9, 11, and 12 with the exception of disclosing the claimed outlet sizes. However, the sizing of an outlet is simply a design choice. An outlet is designed depending on the environment it will be used in. Depending on the environment the outlet is used in, the size of the outlet bores will vary. Thus at the time of the invention it would have been obvious for one having ordinary skill in the art to have sized the outlets in the manner claimed in claims 2, 4, 5, 9, 11, and 12 because it is known in the art to change the size of a well production outlet depending on the environment the outlet is to be used in.

### ***Response to Arguments***

6. Applicant's arguments filed 10/21/03 have been fully considered but they are not persuasive.

Multiple Production Outlets Connected to a Horizontal Production Passage Connected to a Vertical Production Bore

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Though Wolff et al. does not specifically state that the two passages (containing valves WV-1 and WV-2) are connected to the production bore; a complete reading of the patent proves that this must be true. Wolff et al. states that the Christmas tree (X) is connected to the production tubing (T), and that the WV valves control the flow of fluids in the Christmas tree (column 3, lines 33-56). This certainly suggests that fluid is flowing from T to X and out through the WV valves. In addition, the WV valves are attached to the emergency shutdown system (ESD) (column 4, lines 40-61). If both valves were not conducting the production stream, there would be no need to connect both of them to the emergency shutdown. Finally, Wolff et al. states that in order to shut in the well, both WV valves must be closed before the master valve (MV) to prevent damage from the MV trying to close on a moving stream (column 16, lines 48-57). If both WV valves were not controlling the production stream flowing through the MV, then it would not be necessary to close both of them before closing the MV to prevent damage to the MV. These valves are located at either end of a production passage (see figure 1). This production passage is horizontal (see figure 1). This production passage intersects a vertical production bore (see figure 1; production bore runs from WL1 to MV).

#### Horizontal Christmas Tree

On page 4, of the response dated 10/ 21/03 applicant states that a horizontal Christmas tree is "well understood by the person of ordinary skill in the art [to include] a tubing hanger which is landed in the tree and which comprises a vertical production bore that is connected to the well and a horizontal production outlet." However, the applicant has

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provided no evidence that a person of ordinary skill in the art would interpret the phrase "horizontal Christmas tree" in such a manner. Additionally, applicant's drawings and specification include no reference to the instant invention being a tubing hanger inside a Christmas tree. Thus the phrase "horizontal Christmas tree" will continue to be given the broadest reasonable interpretation, which is in accordance with figure 1 and page 2 of the instant application where applicant states that horizontal Christmas trees have a horizontal production outlet branched off a vertical bore. Thus, per applicant's own definition, Wolff et al. does show a horizontal Christmas tree: it has horizontal production outlets (outlets with the WV valves) branching off a vertical bore (T).

### ***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer Dougherty whose telephone number is (703) 308-6365. The examiner can normally be reached on Monday-Thursday from 7:30 AM to 5:00 PM (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell, can be reached on (703) 308-2151. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3597.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

  
DAVID BAGNELL  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600

  
Jrd

November 25, 2003